



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,115	01/17/2002	Paul E. Carlson		1646

7590 02/21/2003  
William L. Kraye  
1771 Helen Drive  
Pittsburgh, PA 15216

EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
----------	--------------

1614

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/052,115	Applicant(s) CARLSON ET AL	
	Examiner Clinton Ostrup	Art Unit 1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other:  |

### DETAILED ACTION

Claims 1-18 are pending in this application.

#### ***Priority***

Priority to Provisional Application Number 60/264,611, filed January 27, 2001 has been acknowledged.

However, If applicant desires priority to a provisional US application under 35 U.S.C. 119(e), not 35 U.S.C. 120, as stated in the oath, based upon a previously filed provisional copending application, specific reference to the earlier filed application must be made in the instant application. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. \_\_\_\_\_" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application. In the instant application an exemplary statement might read "This application claims benefit of Provision U.S. Application No. 60/264,611, filed January 27, 2001."

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35

Art Unit: 1614

U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

#### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor **or** inventors of the subject matter which is claimed and for which a patent is sought. (Bolding added for emphasis).

It does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to **patentability** as defined in 37 CFR 1.56. (Bolding added for emphasis).

Art Unit: 1614

The claim for priority incorrectly claims benefit under 35 U.S.C. 120, wherein claims of priority to provisional applications must be made under 35 U.S.C. 119(e).

### ***Specification***

The disclosure is objected to because of the following informalities: Xanthan is capitalized throughout the application. However, Xanthan is not a Trademark or a proper name and should not be capitalized. Moreover, on page 7 "nitrilopropionamide" has been misspelled as "nitrilipropionamide" on several occasions. See: page 7, lines 2-6. Also, a period appears to be missing between "nitrilopropionamide" and "A" on page 7, line 7.

Appropriate correction is required.

### ***Claim Objections***

Claims 1, 3, 5, 7, 13, 14, and 16 are objected to because of the following informalities:

Claims 1, 5, 7, 13, and 14 are objected to because "Xanthan" is capitalized. Xanthan is not a trademark or a proper name and therefore, it should not be capitalized in these claims.

Claims 3 and 16 are objected to because "2,2 dibromo 3-nitrilopropionamide" has been misspelled as "2,2 dibromo 3-nitrilipropionamide". (Bolding added for emphasis).

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "2,2-dibromo-2-cyano-N,N-dimethylacetamide" in claim 4 is confusing because it is not a term of art. The examiner assumed, for examination purposes, applicant meant "2-bromo-2-cyano-N,N-dimethylacetamide." However, if in fact applicant meant 2-bromo-2-cyano-N,N-dimethylacetamide, this claim is essentially the same as claim , because 2-bromo-2-cyano-N,N-dimethylacetamide is simply another name for 2,2-dibromo-3-nitrilopropionamide.

Claim 17 recites the limitation "said 2,2 dibromo 3-nitrilopropionamide", however, there is insufficient antecedent basis for this limitation in the claim. This rejection could be overcome by correcting the spelling of "2,2 dibromo 3-nitrilopropionamide" in claim 16 to "2,2 dibromo 3-nitrilopropionamide."

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Art Unit: 1614

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gartner 5,627,135 and further in view of Miskiel et al., 6,083,890.

Gartner teaches stable, concentrated aqueous suspensions comprising 2,2-dibromo-3-nitilopropionamide (DBNPA) in the presence of a thixotrope that exhibits Ellis-Plastic behavior, and teaches xanthan gum as an example of such thixotropic agents. The reference teaches the pH of said aqueous suspensions in a range from about 1 to about 4, a pH range which overlaps that of the range claimed instantly. See: abstract, col. 2, line 25 – col. 3, line 63.

The primary reference teaches that DBNPA degrades at higher pH's and in general almost any acidifying agent may be used and specifically teaches acetic acid as an example of an acidifying agent. The reference teaches DBNPA in amounts which overlap those as claimed instantly in claims 7, 8, 10-12, and 17. The reference teaches amounts of a suspending agent, which overlap the amounts of acetate-free xanthan gum as claimed instantly in claims 13-14. See: col. 4, line 45 - col. 6, line 22; and claims 1-12.

Although the primary reference teaches a stable, aqueous suspension of DBNPA in amounts claimed instantly in a thixotrope, such as xanthan gum, having a pH which overlaps the pH claimed instantly, the primary reference lacks the acetate-free xanthan gum and sodium acetate as claimed instantly in claims 1-18.

Art Unit: 1614

Miskiel et al., teach an improved acidic cleaning composition comprising a low acetate xanthan gum as a rheological control agent, which exhibits greater, longer lasting stability and shelf life when compared to acidic cleaning compositions with xanthan gum.

The secondary reference teaches that xanthan gum is a well-known rheology modifier in cleansers, but it has the undesirable characteristic of not being able to maintain the viscosity of compositions having a low pH. However, Miskiel et al., have surprisingly and unexpectedly found that if the content of acetate in xanthan gum is at or below 1.2% there is a significant improvement in the viscosity stability of the acidic cleanser compositions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the compositions of Gartner by substituting acetate-free xanthan gum for xanthan gum because of the reasonable expectation of obtaining an improved cleansing composition with superior viscosity and stability.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Karbowski et al., 4,800,082 teaches sustained release microbial control compositions comprising hydrophilic polymers and DBNPA.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).



Art Unit: 1614

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup  
Examiner  
Art Unit 1614

February 14, 2003



FREDERICK ARAGO  
PRIMARY EXAMINER  
Art Unit 1614  
